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No.0689 P. 18

**REMARKS**

**Claim 1 was rejected under 35 USC 102(b) as being anticipated by Downey (U.S. 3,420,266).**

5 Downey lacks the claimed passageway communicating between the chamber and the filter. The Primary Examiner states that “[a] tubular passageway defining (sic) by seat member 16 communicates between an outer surface of the filter and the chamber.” Assuming, arguendo, that the Primary Examiner’s characterization of Downey is correct it does not meet claim because the claim recites a passageway between the chamber and 10 the filter, not a passageway through the filter. Valve seat 16, assuming arguendo that its proper to characterize it as a passageway, does not reside between the chamber and the filter. Applicant specifically disputes that a valve seat can be characterized as a passageway. Rather, a valve seat is a surface against which a valve presses in order to hut off valve flow.

15 The Primary Examiner states that it is his position that the preamble language of claim 1 which recites a “water” filtration device fails to further limit the claimed structure. The Primary Examiner takes the position that the language in the body of claim 1 which recites the filter as a “water” filter fails to further limit the claimed structure. Applicant disagrees. MPEP Section 2111.02, Effect of Preamble, indicates that the 20 Examiner’s position does not appear to be well founded when the patent application is

read as a whole.

The Primary Examiner states that further that "it is pointed out that although Downey exemplifies a fuel filter, his invention is not limited thereto (see e.g. col. 1 lines 10-15) implying that the invention of Downey is applicable for use in a water filter. The 5 cited language of Downey, however, exemplifies that the "primary object of the invention is to provide an improved combination fluid by-pass valve and condition indicator therefor for use in fluid flow equipment including filters." Downey does not use the word water and it is not believed that Downey is directed to water filters in any way.

Anticipation requires that there be an identity of invention. Anticipation requires 10 that all elements and limitations of the claim are found within a single prior art reference. There must be no difference between the claimed invention and the reference disclosure. *Carella v. Starlight Archery and ProLine Co.*, 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed. Cir. 1986). *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549, 220 USPQ 193, 198 (Fed. Cir. 1983). *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 781 (Fed. Cir. 1983).

15 Reconsideration of claim 1 is respectfully requested.

Claims 1-7, 26-27, 52 and 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,024,867 issued to Parise in view of US Patent 3,857,277 issued to Moore.

### Claim 1

20 The Primary Examiner correctly observes that "Parise doesn't teach a gate that

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swings between positions including a magnet affixed thereto." (Emphasis ours) Parise also does not disclose a chamber in which the gate resides. Parise also does not disclose a passageway communicating between the chamber and the filter. The Examiner has not identified the claimed chamber or the claimed passageway between the chamber and the filter.

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The Primary Examiner states that "[i]t would have been obvious to one ordinarily skilled in the art at the time of the invention to have the indicating device of Moore in the outlet flow channel of Parise..." The Primary Examiner does not identify the outlet flow channel of Parise in which the industrial elastomeric flapper visual indicator of Moore is supposed to be mounted. Nor has the Primary Examiner identified any motivation or suggestion (explicit or implicit) in Parise as to the desirability for incorporating the industrial elastomeric flapper visual indicator of Moore. Parise is directed toward a sink top water filter which is connected to the sink faucet and Moore is directed to industrial flow monitor having a flapper 20. Flapper 20 includes an integral bead (col. 2, lns. 14 et seq.) which is mounted in the housing by sliding bead/head 26 into the housing.

Flapper 20 is not a gate and does not swing or rotate as suggested by the Primary Examiner. Flapper 20 bends/flexes as illustrated in Fig. 1 and as explained at col. 3, lns. 28 et seq.

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MPEP section 2143.01 indicates that the prior art must suggest the desirability of

the claimed invention. "Obviousness can only be established by combining or modifying

the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. 'The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.' Here, it is respectfully suggested that the Examiner is improperly combining the references. There is no basis for combining the references as no teaching, suggestion, or motivation is explicitly or implicitly found in the references to arrive at the instant invention as claimed.

10        In *In re Kotzab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) the court held that a "finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the claimed invention] to make the combination in the manner claimed" must be made. In the instant application, the Primary Examiner has not identified a specific understanding or principle within the knowledge of the skilled artisan that would have motivated one with no knowledge of the claimed invention to make the combination in the manner claimed. Nowhere does the Primary Examiner identify the artisan given the differences in the problems to be solved, nor does the Examiner explain the motivation for combining the structure of the references. Nor does the Primary Examiner identify how the references would be modified other than broad general statements without any structural basis therefor.

It must be remembered that a person of ordinary skill in the art is a person that would not innovate. A person of ordinary skill in the art is one who thinks along the line of conventional wisdom and does not take to innovate. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 454, 227 USPQ 293 (Fed. Cir. 1985). The Primary Examiner has not identified why a person of ordinary skill in the art of water filters would combine the teachings of Parise and Moore.

**Claims 2-7.**

Claims 2-7 are allowable as being dependent directly or indirectly on allowable claim 1. There is no disclosure in Parise or Moore in regard to a totalizing algorithm (cls. 10 3 and 4),

**Claim 26.**

Neither Parise nor Moore disclose a wet chamber formed within the water filter housing.

Neither Parise nor Moore disclose the claimed **water filter non-removably contained within the water filter housing**. In fact, Parise teaches away from the claimed structure in that it specifically provides for the replacement of the filter and for the replacement of the electronics associated with the removable water filter. According to the invention defined by claim 26 when the filter is worn the device is discarded. This is fundamentally different than Parise.

20 Neither Parise nor Moore disclose a passageway communicating between the wet

chamber and the water filter.

Neither Parise nor Moore disclose a gate having a magnet affixed thereto and residing in the chamber. The Examiner states "the examiner contends that the ball-shaped magnetic (sic) 22 within the flap 20 of Moore would be similar" to Parise insofar as 5 "Parise is not limited to his shown ball configuration see e.g. the scope of his claim 1 and col. 6, line 33 which states that similar objects can be used." The ball-shaped magnet that the Primary Examiner is referring to is believed to be a bar magnet 22. It is unclear if the Primary Examiner is suggesting that the bar magnet 22 of Moore be used in place of the 10 balls 115 of Parise. It is not believed that the bar magnet 22 of Moore could be used in place of balls 115 of Parise. The undersigned does not understand the Primary Examiner and it is respectfully suggested to the extent understood that the Primary Examiner's 15 position is flawed.

Neither Parise nor Moore include a gate swinging between first and second positions. Flapper 20 of Moore flexes and bends but does not rotate. See Fig. 1 of 15 Moore.

Neither Parise nor Moore include a gate position sensor in an end cap of the water filter housing.

The arguments made in regard to claim 1 are equally applicable to claim 26 and are not repeated here but are incorporated herein by reference. It is respectfully suggested 20 that Parise and Moore are grossly insufficient as most of the claimed structure cannot be

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found in either reference and there is no explicit or implicit motivation to combine them as claimed. It appears that the Primary Examiner has impermissible sifted through the art in attempt to arrive at the structure as claimed in claim 26. This amounts to an attempt at hindsight reconstruction using unrelated bits and pieces of the references to arrive at the claimed invention as recited in claim 26. *In re Vacek*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1990); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1999).

Reconsideration of claim 26 is respectfully requested.

**Claim 27**

10 Claim 27 is patentable for at least the reason that claim 26 is patentable.

Reconsideration of claim 27 is requested.

**Claim 28 was rejected under 35 USC 103(a) as being unpatentable over Parise in view of Moore as applied to claim 27 above and in further view of Downey.**

15 Neither Parise nor Moore disclose the water filter affixed to a first end cap and a second end cap. Neither Parise nor Moore disclose that the first end cap of the filter includes a first hinge member and that the gate includes a second hinge member which coacts with the first hinge member to enable the gate to swing between first and second positions. Moore does not disclose hinge members and flapper 20 of Moore is not a gate as stated previously.

20 The Primary Examiner seems to say that it would have been obvious to have the

filter end caps (elements 7b + 18) of the modified Parise to include the hinged gate of Downey. The Primary Examiner appears to be stating that the bypass valve of Downey should somehow be installed in Parise to arrive at the invention of claim 28. The primary Examiner appears to be equating the cylindrical fuel filter of Downey with an end cap and then (it is believed) attempts to justify incorporation and substitution of the bypass valve of Downey for the fitting and the upper end cap 7b of Parise. First, no motivation or suggestion implicit or explicit for this modification has been identified by the Primary Examiner. Secondly, the Primary Examiner has not identified why a bypass valve would be used in the first place in a situation which does not require a bypass valve.

10 Reconsideration of claim 28 is requested as it is believed that the rejection of claim 28 is not warranted.

**Claim 52**

Claim 52 is dependent on allowable claim 1. Reconsideration of claim 52 is requested.

15 **Claims 60-63**

As stated above neither Parise nor Moore disclose a gate or a gate rotatable between first and second positions. Flapper 20 of Moore is not a gate and it does not rotate. Claim 60 recites a rotatable gate in combination with other structure. Claims 61-63 are dependent directly or indirectly on claim 60 and are patentable for at least the reason that claim 60 is patentable.

Reconsideration of claims 60-63 is requested.

Several information disclosure statements were not returned to the undersigned as having been considered. They are attached hereto and are indicated on public pair.

The Primary Examiner should be aware of co-pending application serial nos. and publications, to wit: 20050092661; 11/264,239; 29/241,767; 11/256,133; 11/256,403; 5 11/256,132; 11/255,670; 11/255,715; and 11/256,064; all of which have been previously identified by the IDS filed with the office before the first substantive office action.

Reconsideration of claims 1-7, 26-28, 52 and 60-63 is respectfully requested.

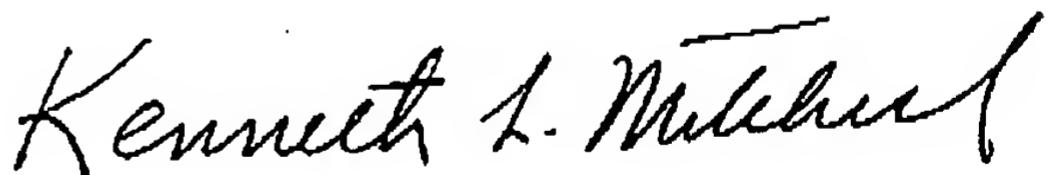
The undersigned invites a telephone call from the Examiner if it would expedite 10 the processing and examination of the application. Applicants would like to thank the Examiner for his careful review of the application.

Favorable action is solicited.

If there are any additional charges, or any overpayment, in connection with the 15 filing of the amendment, the Commissioner is hereby authorized to charge any such deficiency, or credit any such overpayment, to Deposit Account No. 23-3060.

Respectfully submitted,

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